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P.O. BOX 1450
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Lowe Hauptman Gopstein Gillman & Berner LLP
c/o Kenneth M Berner
Suite 310
1700 Diagonal Road
Alexandria VA 22314

In re Application of:
Thomas S. Heath
Application Serial No.: 09/577,487
Filed: May 25, 2000
For: **VIDEO MOSAIC**

MAILED

JUN 24 2005

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

DECISION
ON PETITION

This is a decision on the petition to withdraw the final action as premature, filed May 25, 2005, pursuant to 37 CFR § 1.181.

Petitioner alleges that the examiner erred in holding the Office action mailed February 25, 2005 final and requests withdrawal of finality of the Office action. It has been contended by the petitioner that the examiner has entered a new grounds of rejection that was neither necessitated by amendment or based upon information cited in an information disclosure statement.

A review of the file record reveals that a non-final Office action was mailed on February 13, 2004 rejecting: claims 1, 13-15 as being anticipated by Burt et al.; claims 2-4, 6-7 as being unpatentable over Burt et al.; claim 5 as being unpatentable over Burt et al. in view of Yagi et al.; claims 8-10 as being unpatentable over Burt et al., Yagi et al. and Takiguchi et al.; and finally claims 11-12 as being unpatentable over Burt et al., in view of Takiguchi et al.

On May 13, 2004, applicant filed an amendment which cancelled claims 5-6, amended all the independent claims 1, 13-15 and amended dependent claims 8-9 and 11-12.

On July 27, 2004, a final Office action was mailed rejecting claims 1-4, 7-10, 12-15 as being unpatentable over Burt et al. in view of Yagi et al. and Takiguchi et al.

On December 23, 2004, applicants filed a response to the outstanding Office action, presenting arguments as to why the examiner's holding was incorrect.

On February 1, 2005, an interview summary was made of record whereby the examiner states "Applicants arguments in the After Final amendment dated 12/23/2004 which have been found to be persuasive, a new office action will be mailed. Therefore, the office action mailed 07/27/2004 is hereby vacated..."

On February 25, 2005, a new final Office action was mailed which rejected claims 1-4, 7, 11-15 as being unpatentable over Hsieh et al. in view of Burt et al.

The issue here is the appropriateness of the final Office action mailed February 25, 2005.

MPEP §706.07(a) [R-1] Final Rejection, When Proper on Second Action, states in part:...

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

In the instant application, given that the interview summary states that the July 27, 2004 final Office action was "vacated", then it is as though the final Office action mailed July 27, 2004 was not ever mailed. Therefore, the status of the application prior to the now vacated final Office action mailed July 27, 2004 would have been applicant had filed an amendment which cancelled claims 5-6, amended all the independent claims 1, 13-15 and amended dependent claims 8- 9 and 11-12.

The amendment filed May 13, 2004 amended and altered the scope of the independent claims. Thus, the new grounds of rejection in the final Office action mailed February 25, 2005, was necessitated by applicant's amendment and in accordance with MPEP §706.07(a) the action was appropriately made final.

Accordingly, given that applicant's amendment necessitated the new grounds of rejection in the outstanding final rejection, the petition to hold the outstanding finality of the Office action as being premature, is **Denied**.

The application file will be forwarded to the Technology Center's technical support staff for entry of the amendment which accompanied the petition, as an After Final amendment. From there, the application file will be forwarded to the examiner for appropriate action in due course.



Andrew Faile, Acting Director
Technology Center 2600
Communications